

**C. APPLICANT'S COMMENTS**

Claims 1-7, 9-20 are pending in this Application, with Claims 1, 11 being amended and Claims 21-29 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-7, 9-20 and favorable consideration of Claims 21-29 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

**Paragraph 2 of the Office Action**

**A. *Overview***

The Official Action rejected Claims 1-18, 20 under 35 U.S.C. §102(b) as being anticipated by Przilas et al. (U.S. Patent No. 5,907,473). The Applicant respectfully disagrees with this rejection for at least the following reasons.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under 35 U.S.C. §102(b), anticipation requires that the prior art reference both (1) disclose, either expressly or under the principles of inherency, every limitation of the claim, and (2) be enabling thus placing the allegedly disclosed matter in the possession of the public.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."<sup>1</sup> "The identical invention must be shown in as complete detail as is contained in the ... claim."<sup>2</sup> Hence, under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art.<sup>3</sup> Anticipation also requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.<sup>4</sup> In addition, the prior

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<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

<sup>3</sup> *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

<sup>4</sup> *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public.<sup>5</sup>

**B. Independent Claims 1 and 11**

Independent Claim 1 has the following features:

1. (Currently Amended) A spray cool system with a dry access chamber, comprising:

**a chassis having a wet chamber and a dry chamber**, wherein said wet chamber is for thermally managing an electronic device by applying liquid coolant to an electronic device within said wet chamber;

**a dry access door** removably attached about said dry chamber, wherein said dry access door completely seals said dry chamber; and

**a wet access door** removably attached about said wet chamber, wherein said wet access door completely seals said wet chamber.

Independent Claim 11 has the following features:

11. (Currently Amended) A spray cool system with a dry access chamber, comprising:

**a chassis having a wet chamber and a dry chamber**, wherein said wet chamber is for thermally managing an electronic device by applying liquid coolant to an electronic device within said wet chamber;

wherein said wet chamber includes a coolant spray system for thermally managing an electronic device;

wherein said dry chamber includes a coolant system fluidly connected to said coolant spray system;

**a dry access door** removably attached about said dry chamber, wherein said dry access door completely seals said dry chamber; and

**a wet access door** removably attached about said wet chamber, wherein said wet access door completely seals said wet chamber.

**C. Przilas Does Not Teach a “Dry Chamber”**

Przilas does not teach a “dry chamber.” The alleged dry chamber of Przilas is merely an air flow channel to direct the air around the exterior of the wet chamber wherein the “external fins (25)” dissipate heat from the wet chamber of Przilas (“*A plurality of external fins 25 are located on the exterior wall of the closed compartment 22 to increase the surface area of the exterior wall.*”). More particularly, Przilas states:

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<sup>5</sup> *Akzo N.V. v. United States Int’l Trade Comm’n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S.

The first embodiment of the condensing system 56 is illustrated in FIG. 2. The condensing system 56 includes two fans 58 that draw cool air across the closed compartment 22 from an air intake 60. Convective cooling of the condensing system 56 results from cool air passing over the closed compartment 22 which reduces the temperature of the exterior walls of the closed compartment and causes the vaporized heat transfer fluid 36 to condense. A plurality of external fins 25 are located on the exterior wall of the closed compartment 22 to increase the surface area of the exterior wall. The fans 58 and air intake 60 are mounted to the spray cooled chassis 100. (Starting on Column 7, Line 63 and continuing to Column 8, Line 7.).

The space shown in Figure 2 of Przilas is merely a channel to direct the flow of air about the wet chamber and is not sealed. Independent Claims 1 and 11 (as amended) now include the feature of

Furthermore, there is no reason to seal the space around the wet chamber since all of the operational components of the coolant system are located within the wet chamber. The present invention, and particularly Claim 11, utilize the dry chamber to receive the “coolant system” which Przilas simply does not teach or suggest. To seal the space around the wet chamber of Przilas would actually frustrate the purpose of the space – it would prevent air flow about the wet chamber.

The Applicant respectfully submits that Przilas does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Przilas does not disclose (expressly or inherently) all of the features of independent Claims 1, 11. Therefore, Applicant respectfully submits that independent Claims 1, 11 are patentable over the cited reference for at least these reasons. Accordingly, Applicant respectfully requests that the Examiner withdraw the outstanding rejection as applied to independent Claims 1, 11, since the application is in condition for allowance.

**Paragraph 3 of the Office Action**

The Official Action rejected Claim 19 under 35 U.S.C. §103(a) as being unpatentable over Przilas in view of Crowley (U.S. Patent No. 6,452,788). The Applicant respectfully disagrees with this rejection of these claims for at least the following reasons.

***i. Burden on Examiner to Establish Prima Facie Case***

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.<sup>6</sup> When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned upon appeal.<sup>7</sup> “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”<sup>8</sup>

“To establish a *prima facie* case of obviousness, three basic criteria must be met.”<sup>9</sup> First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.<sup>10</sup>

***ii. Legal Requirements for Obviousness***

“Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and

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<sup>6</sup> *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

<sup>7</sup> *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

<sup>8</sup> *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

<sup>9</sup> MPEP §706.02(j).

combine them to produce the claimed combination.”<sup>11</sup> “An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art.”<sup>12</sup> “As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the **field of the specific invention**, the **subject matter of the references**, the extent to which they are **in the same or related fields of technology**, the **nature of the advance** made by the applicant, and the **maturity and congestion of the field**.”<sup>13</sup> Obviousness requires proof “that the skilled artisan ... would select the elements from the cited prior art references for combination in the manner claimed.”<sup>14</sup>

It is further submitted that combining elements from different prior art references must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

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<sup>10</sup> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

<sup>11</sup> *In re Johnston*, 435 F.3d 1381, 2006 WL 213719 (Fed. Cir. 2006) (citing *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.”); *In re Dance*, 160 F.3d 1339, 1343 (Fed.Cir.1998) (“When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.”); *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988) (there must be “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed.Cir.1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

<sup>12</sup> *Id.*

<sup>13</sup> *Id.*

<sup>14</sup> *In re Rouffet*, 149 F.3d 1350, 1358 (Fed.Cir.1998).

*In re Fritch*, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

*Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

### *iii. Analysis*

The Office Action admits that Przilas fails to teach a dry access door pivotally attached to the chassis. (Office Action, Page 5.). However, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there is no reasonable expectation of success of combining the teachings of the references since Crowley merely teaches a basic cover whereas the purported cover (16) in Przilas includes various components that would prevent the usage of a pivoting door structure. Finally, the prior art references when combined do not teach or suggest all the claim limitations.

For these reasons, among others, the combination of Przilas with Crowley cannot suggest the combination of features in applicant's Claim 19 and it is therefore submitted that the rejection against these claims should be withdrawn and Claim 19 allowed.

**Added Claims 21-29**

The Applicant has added independent Claim 21 which includes the features of originally filed independent Claim 1 along with the feature of “wherein said wet access door is exposed externally of said dry chamber.” The Applicant respectfully submits that Przilas does not teach or suggest a wet access door for a wet chamber “wherein said wet access door is exposed externally of said dry chamber.” Accordingly, Claims 21-29 are respectfully submitted to be in condition for allowance.

**D. CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner’s Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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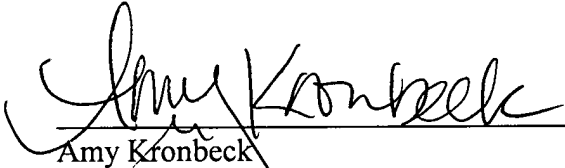
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